

arc as shown. Fig. 12 has been amended in accordance with the Examiner's instructions and, as amended, refers to cross sectional view "XIII-XIII" depicted in Fig. 13. Appropriate change to the Specification in reference to the amended drawings has been made.

#### IN THE SPECIFICATION

The amendments to paragraphs and sections of the Specification are presented on separate sheets of paper and submitted herewith in accordance with 37 CFR 1.125. The Brief Description of the Drawings has been amended in reference to Fig. 12, to recite correction to the cross sectional view therein as "XIII-XIII". Also, typographical errors have been corrected on page 6 of the Specification, line 122 and at line 130.

The Abstract of the Invention has been amended in accordance with the Examiner's instructions in reference to MPEP Section 608.01 (b) and is submitted herewith.

#### IN THE CLAIMS

The amendments to the claims are presented on separate sheets of paper and submitted herewith in accordance with the revised 37 CFR 1.121.

Claim 11 has been amended to clarify that all the disk-shaped pouches have the same structure and to establish proper antecedent basis in the claim. Accordingly, Applicant claims a plurality of disk-shaped pouches in order to establish that each disk-shaped pouch, as then defined in the claim, has identical structure. The Examiner is thanked for his suggestion. Claim 12 has been amended for clarity as obviously shown in the amended form.

#### CLAIM REJECTIONS

Reconsideration is requested of the rejection of claim 14 under 35 U.S.C. 103 (a) as being unpatentable over Reinhold (US Patent No. 1,498,577) in view of Balzer (US Pub. No.

2003/0010815).

Reinhold discloses a circular case for containing two records and is rather concerned with a filler or spacer for the proper separation of the records stored in the case, than providing a novel means for indicia as claimed by Applicant. Reinhold prefers conventional means for indicia by including indicia on the *face* of one or both sides of the case, obviating the need for tabs and teaching away from the indicia tab of the instant claim<sup>14</sup> (See Reinhold, first Col. L. 35-43).

Reinhold expressly rejects the concept of the square container of Balzer, teaching this type of container is “not satisfactory” for storing records because it “allows the corners to bend over” (See Reinhold, first Col, L. 19-25). Consequently, in light of Reinhold the artisan is unmotivated, and even discouraged from looking to Balzer for including an indicia tab at the periphery of Reinhold’s record case.

Balzer discloses the square sleeve, rejected by Reinhold, and includes an indicia tab b which protrudes from the top edge of the sleeve. Even when acknowledging the limitation of the rectilinear configuration of its tabs (“...the width of the sleeve limits the number of tabs b to be placed across the sleeve.”) (Page 3 [0053]), Balzer *still* prefers the square sleeve and goes against Reinhold. Therefore, it would not have been obvious to the artisan to modify Reinhold in view of the teachings of Balzer as alleged by the Examiner. The mere fact that the prior art could be modified would not have made the prior art obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 10 USPQ 2d 1397.

Balzer suggests and discloses nothing more than a rectilinear configuration of tabs and placement of each tab b is limited to the width of the sleeve as shown in the drawings of Balzer. Balzer is rather concerned with removable tabs rather than solving its disclosed limitation. Balzer

does not even recognize this limitation as a problem in the art. Applicant, however, has solved the limitation by using a rotational tab, providing the user a greater field of visibility and placement well beyond the limited width of Balzer's sleeve. For example, in the amended Fig. 18 of the instant Specification, the arrows indicate that at least 180 degrees of arc is available for sideways thumbing of Applicant's indicia tab, as opposed to thumbing *through* the index of tabs in Balzer (see Balzer, page 4 [0057]). Discovering and solving a problem in the art is indicative of non-obviousness.

*Ex Parte Dussaud*, 7 USPQ 2<sup>nd</sup> 1818, involving a process of making disposable diapers, held that the artisan would not have found it obvious to substitute a single roller wherein elastic strips are applied to a diaper in a straight line, for a pair of rollers whose objective is to apply elastic strips to a diaper in a curvilinear profile. Likewise, without having the benefit of applicant's disclosure, the artisan would view the square sleeve in Balzer as serving an important function in positioning tab b along a straight line, and would not find it obvious to substitute the round case of Reinhold for the square sleeve of Balzer. In other words, without applicant's disclosure the artisan has no motivation to modify Reinhold in view of Balzer to arrive at applicant's disk-shaped pouch, having a tab in position along the curvature of the pouch.

Reconsideration is next requested of the rejection of Claim 15 under 35 U.S.C. 103 (a) as being unpatenable over Reinhold (U.S. Patent No 1,498,577) in view of Balzer (US Publication No. 2003/0010815) as applied to claim 14 in the Office Action and further in view of Kohn (U.S. Patent No. 1,295,763).

The deficiencies of Reinhold and Balzer have been noted above as applied to claim 14. For the following reasons Kohn neither cures any of these deficiencies nor provides any teaching

to suggest or disclose the instant claim 15. As noted above, Balzer teaches placing a compact disk in a square pouch and Reinhold teaches against a square pouch. Reinhold and Balzer teach against each other and cannot be combined to arrive at the instant claimed invention, irrespective of whether the containers of Balzer or Reinhold can hold a wide range of audio devices as within the purview of one skilled in the art.

Kohn discloses a record sleeve with a central hole. It is absolutely essential in Kohn that the hole in the sleeve is larger than the central hole in the record it contains, so that the indicia in the central portion of the record can be “visible through” the hole in the sleeve. This reference cannot suggest or disclose the instant claim 15, wherein it is essential that the hole in the disk-shaped pouch is *congruent* with the hole in the compact disk as claimed therein. See for example Fig 11 of the instant Specification wherein congruent holes in the pouch and the associated compact disk are clearly shown, as compared to the Figure in Kohn, wherein the holes in the disk and sleeve cannot be congruent because this defeats the object of Kohn’s record sleeve. The central portion of the record in Kohn must be viewed through the hole in the sleeve. This is contrary to the instant claimed invention, wherein indicia cannot be visible through the hole in the disk-shaped pouch. Indicia is rather viewed by means of the instant tabs, otherwise, the object of the instant claimed invention is defeated. Again, the fact that Reinhold could be modified by including the hole in Kohn to arrive at claim 15 is not the test for obviousness. There is no objective teaching in any of the references to provide for congruent holes as instantly claimed.

Reconsideration is requested next of the rejection of claims 11 and 12 under 35 U.S.C. 103 (a) as being unpatenable over Reinhold (U.S. Patent No 1,498,577) in view of Balzer (US Publication No. 2003/0010815) as applied to claim 14 in the Office Action and further in view of

Kawachi (U.S. Patent No. 3,623,615) or Casey et al (U.S. Patent No. 2,917,179).

Once again the deficiencies of Reinhold and Balzer are noted. Contrary to the Examiner's allegation in the Office Action, Reinhold in view of Balzer fails to suggest or disclose applicant's basic inventive concept.

The Office Action on page 6 acknowledges the failure of Reinhold in view of Balzer to suggest or disclose attaching the disk-shaped pouch onto a support means that rests on a horizontal surface. The reason for this is attributed to the disclosure in Balzer and not the absence of such teaching per se in these references so that the artisan is motivated look elsewhere in the art for a support means. It is essential to Balzer to use the preferred box-shaped housing in Fig 11 for a plurality of sleeves, so that one can properly thumb *through* Balzer's index of tabs. (see Balzer, Page 4, [0057]) in contrast to applicant's claimed system of rotational sorting. As already noted, Reinhold teaches that a square sleeve allows the corners to bend and is unsuitable in keeping with the objects of Rheinhold's invention. The artisan is even further unmotivated to modify Reinhold in view of Balzer because of the box-shaped housing in Fig 11 of Balzer when incorporating a plurality of sleeves. One skilled in the art would not pick and choose the tabs of Balzer to modify Reinhold's double record case, and ignore Balzer's box-shaped housing in the process. In this case, the box-shaped housing of Balzer reinforces applicant's position that Reinhold and Balzer themselves do not teach they can be combined. In other words, without the benefit of applicant's disclosure the artisan would fail to recognize that Balzer's housing is not suitable for a plurality of Reinhold's circular case and be content with Balzer's limited teaching. Therefore, the artisan would not bother to look to Kawachi or Casey et al for placing a plurality of Applicant's disk-shaped pouch onto a support means which rest on a horizontal surface, let

alone that Kawachi and Casey et al have nothing to do with indicia tabs, lacking sufficient teaching in themselves to motivate the artisan toward these patents.

In point of fact, the tabs shown in Fig's 1-8 of Kawachi are directed solely for mechanical purposes, that is, for the pivotal extraction of the reel cases shown therein. The "devices" of Kawachi are for storing photographic film or data processing tapes and having nothing to do with disks. Rotational movement about a common axis, if anything, is directed to configure the mechanical tabs for extraction of the film containing reel cases. (See Kawachi Col.3 L 48-58) Kawachi is not concerned with rotational indicia tabs in a system of sorting and retrieving compact disks for purposes of obviousness.

In fact, Kawachi teaches against the indicia tab altogether. Kawachi pays particular attention in demonstrating that indicia should appear on the reel case itself, sandwiched between the mechanical tabs 34 and 32; ironic in terms of the instant claims. (See Kawachi, Fig. 8). In Kawachi, the face of tabs 34 and 32 are parallel to the axis of rotation (See Kawachi, Fig. 1) and cannot be viewed along the axis. On the other hand, the face of the instantly claimed tabs are perpendicular to the axis of rotation for containing viewable indicia along the axis of rotation, as shown in the instant plurality drawings especially in Fig. 1 of the instant Specification. Clearly, Kawachi's mechanical tabs are unsuitable for containing indicia and teach against the same. It is error to conjecture that the combined teaching in the art includes a plurality of Kawachi's "devices" in order to suggest or disclose a plurality of disk-shaped pouches placed onto a support means as claimed herein.

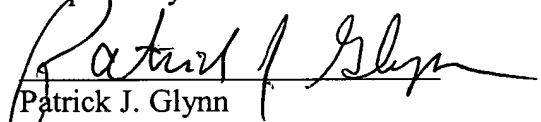
The housing in Casey et al is adapted for storing records outside a container or sleeve and, in this regard, is even further removed from the instant claims than Kawachi. Casey et al

guards against any movement of the records, let alone rotation about a common axis of the housing. The housing in Casey et al is adapted to "receive the edges of the records snugly... while also restraining the records from rattling." (Col. 2, L64-66) One skilled in not motivated to rotate records or adapt the housing of Casey et al to arrive at the instant claims.

In summary, the teachings in the references of record are limited to their own disclosures, such that the references themselves do not suggest they be combined in the manner set forth in the Office Action. "Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex Parte Levengood*, 28 USPQ 2nd 1300. Furthermore, it is error to find obviousness where the references diverge from and teach away from the invention at hand as discussed above. *In re Fine*, 5 USPQ 2<sup>nd</sup> 1596.

Based on the foregoing, Applicant requests the rejection be withdrawn and early allowance of the amended claims.

Respectfully submitted




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